

Appl. No. 09/926,599
Amendment dated: August 25, 2003
Reply to OA of: February 26, 2003

REMARKS

Applicants have amended the claims to more particularly define the invention taking into consideration the outstanding Official Action. Claims 2, 4, 14, 15 and 16 have been amended to remove the objected to subject matter. Therefore, it is most respectfully requested that the rejection of claims 2, 4, 13 and 14 under 35 U.S.C. 112, second paragraph, be withdrawn. Applicants most respectfully submit that all the claims now present in the application are in full compliance with 35 U.S.C. 112 and are clearly patentable over the references of record.

The rejection of claims 15-18 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which the invention pertains to make and use the invention has been carefully considered but is most respectfully traversed.

It is stated in the Official Action that the methods set no parameters for one to determine the quality or quantity of treating or repelling an unspecified parasite and unspecified degree of infestation in unspecified animals.

The specification discloses an example for applying the well known sheep dip method (page 7, lines 8-32), including disclosure of the amount of the solution used. The example also discloses that as a result of applying this method, all animals that had been treated showed protection against the ectoparasite during those months in which sheep generally suffer from such infestation. Accordingly, the parameters for treating the animal are disclosed in the specification and enable a person skilled in the art to carry out said method without undue experimentation.

The example also discloses that the ectoparasite is blowfly. However, the specification discloses that the formulation is also effective to induce death of other ectoparasites and it is therefore a routine matter for a person skilled in the art to apply

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the dipping method used for sheep infested with blowfly to animals infested with other ectoparasites.

It is also apparent to a person skilled in the art based on the disclosure in the example that the method may be used to treat different degrees of infestation as the method, when applied to sheep, protected the animals for several months from blowfly infection and also killed the parasites when directly applied in less than one minute.

It is also submitted that it is apparent to a person skilled in the art that the method of the invention which is exemplified for the use in sheep can be used for other animals.

It is therefore submitted that the claims 15-18 fulfill the requirements of 35 U.S.C. 112 when the level of one of ordinary skill in the art is taken into consideration and the fact that routine experimentation is permissible.

The rejection of claims 1-7 and 12-18 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention has been carefully considered but is most respectfully traversed.

The Examiner has also raised an object with regard to claims 1-7 and 12-18 on the basis that they lack enablement as piperonyl is not seen as a food and flavor compound. However, the invention is directed to an antiparasitic composition comprising Eucalyptus oil, Cajeput oil, Lemongrass oil, Clove bud oil, Peppermint oil, Piperonyl and Piperonyl Butoxide and also the use of this composition in treating ectoparasite infestation in an animal. It is submitted that the Examiner's observation that Piperonyl is not classified as a food and flavor compound does not disable the skilled person from carrying out the invention and it is therefore submitted that the claims 1-7 and 12-16 fulfill the requirements of 35 U.S.C. 112.

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The rejection of claims 1-7 and 12-18 under 35 U.S.C. 103(a) as being unpatentable over Harvey-AU 9051365 in view of Van Tonder, '264, Hink et al. '371 and Merck '68 has been carefully considered but is most respectfully traversed.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Harvey discloses a pesticidal formulation effective in controlling ectoparasites containing a parasiticide component and a non-aqueous component wherein the active parasiticide is a mixture of pyrethroid and organophosphate. There is no disclosure that a combination of essential oils as disclosed in the current application can have a pesticidal effect.

Van Tonder et al. discloses an ectopesticidal formulation comprising a pesticide, a polar solvent and an aqueous component. The pesticide is selected from the group

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consisting of synthetic pyrethroid, amidine, chloromethiuron, cyromazine and s-methoprene. There is no disclosure of using any of the essential oils according to the invention.

Hink et al. discloses a method for treating an area infested with ticks or fleas by treatment with linalool, which acts as the pesticidal compound. As shown in the examples, the shampoo provided contains 1 percent linalool which can be found in a large number of flowers and herbs, it does not occur in the essential oil that are components of the composition as claimed in the present invention, i.e., Eucalyptus, Lemongrass, Glove bud, Cajeput and Peppermint.

Hink et al. also discloses that the toxicity of the effective pesticide linalool can be enhanced by combination with piperonyl butoxide or pesticide active terpenes such as citral, geraniol, citronella, eugenol, which can be found in the essential oils of the present invention. However, the effect of these components disclosed in Hink et al. is such that they act as enhancers of the pesticide linalool. There is no disclosure or suggestion of a composition comprising the essential oils of claim 1 together with piperonyl and piperonyl butoxide. Furthermore, there is no disclosure or suggestion that such composition may be used in the treatment of ectoparasitic infestation of an animal. It is submitted that a person skilled in the art would not be able to combine the disclosures of Harvey, Van Tonder and Hink to arrive at the present invention as none of the documents cited disclose or suggests an antiparasitic combination of essential oils as disclosed in the present invention and there is no suggestion that such a composition may be used in the treatment of animals infested with ectoparasites. In re Fritch, 23 USPQ 1780, 1784(Fed Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps."). Accordingly, it is submitted that claims 1-8 and 12-18 fulfill the requirements of 35 U.S.C. 103(a).

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In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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